

REMARKS

The communication of December 30, 2004, has been received and reviewed. Claims 1-20 are currently pending and are subject to a restriction requirement. New claim 21 has been added as set forth herein. Reconsideration is requested.

Responsive to the restriction requirement, applicants elect, with traverse, SEQ ID NO: 1. This election is made with traverse since the Commissioner has determined that up to ten nucleotide sequences will be examined in a single application, it would not be an undue burden on the Examiner to examine four sequences, and it would be an undue burden on the applicants to require the applicants to file, prosecute and pay for four separate applications to have SEQ ID NOS: 1-4 examined.

The Commissioner for Patents recognized this burden on the biotechnology industry. Thus, “the Commissioner has decided *sua sponte* to partially waive the requirements of 37 C.F.R. 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application... [a]ccordingly, in most cases, up to **ten** independent and distinct nucleotide sequences will be examined in a single application **without restriction.**” (M.P.E.P. § 803.04; *see also*, MPEP § 2434, allowing, “in most cases, up to 10 independent and distinct nucleotide sequences” to be examined in a single application) (emphasis added). As such, applicants request examination of only **four** sequences (SEQ ID NOS: 1-4).

Further, since SEQ ID NOS: 1-4 are related, it should not be an undue burden for the Examiner to examine the four sequences together. For instance, SEQ ID NOS: 1-4 are PDHK cDNAs of *Brassica napus*, *Brassica rapa*, *Brassica oleracea* and *Brassica carinata*, respectively, and are related in that the sequences encode a similar protein (*i.e.*, PDHK) and the sequences are all of a single genus (*i.e.*, *Brassica*). (*See*, Sequence Listing of as-filed Specification).

In order to get SEQ ID NOS: 1-4 examined, new claim 21 directed towards a combination of DNA fragments comprising SEQ ID NO:1, SEQ ID NO:2, SEQ ID NO:3 and SEQ ID NO:4 has been added. As stated in the M.P.E.P. “[i]f the selected combination contains ten or fewer sequences, **all of the sequences** of the combination **will be searched.**” (M.P.E.P. § 803.04) (emphasis added).

Applicants also question the statutory and regulatory basis for the finding that each

sequence in the application constitutes an independent and distinct invention within the meaning of 35 U.S.C. § 121. (*cf. M.P.E.P.* § 803.04 (wherein ten nucleotide sequences are allowed in one application)). Thus, applicants respectfully request the Examiner to provide the statutory and regulatory basis for the instant “sequence election.”

As stated in the statute “if two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.” (35 U.S.C. § 121). The rules implementing the statute recite “if two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the **claims** will be restricted” (37 C.F.R. § 1.142) (emphasis added) and “in the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted.” (*Id.* at § 1.146). Although a generic claim may include separate species, the generic claim cannot, by rule, embrace more than one invention. Thus, since SEQ ID NOS: 1-4 are embraced by a single claim, they cannot be separate inventions.

Accordingly, since the Commissioner decided to aid the biotechnology industry and have ten sequences examined in a single application, SEQ ID NOS: 1-4 are related, and the M.P.E.P. indicates that each sequence in a combination claim of up to ten sequences will be examined, substantive examination of the application (including SEQ ID NOS: 1-4) and reconsideration of the restriction requirement are requested.

CONCLUSION

Should the Office determine that additional issues remain which might be resolved by a telephone conference, the Office is invited to contact the applicant's attorney at the address or telephone number given herein.

Respectfully submitted,



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Date: January 27, 2005

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